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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,925	07/10/2000	Carlos Antonio Durate Cano	P-13 Div II	9520
28752	7590	09/03/2004	EXAMINER	
LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			DEVI, SARVAMANGALA J N	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/612,925

Applicant(s)

DURATE CANO ET AL.

Examiner

S. Devi, Ph.D.

Art Unit

1645

*Supplemental Ex parte Quayle Action*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 is/~~are~~ pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/~~are~~ allowable.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Attachment</u> .                   |

**ATTACHMENT TO Supplemental *Ex parte* QUAYLE ACTION**

1) This application is in condition for allowance except for the following formal matter:

The amended specification submitted 06/16/04 and the substitute raw sequence listing filed 06/16/04 recite sequences identified by SEQ ID numbers 11 and 12. The SEQ ID NO: 11 and 12 are described as oligonucleotide primers 1573 and 1575 respectively.

On page 16 of the amended specification, the structural composition of SEQ ID NO: 11 is indicated to be TTCCATGGTAGATAAAAG, whereas the structure of SEQ ID NO: 11 on page 6 of the substitute raw sequence listing filed 06/16/04 is recited as: 'ttccatgta gataaaagaa tggcttag'. It is unclear how the same oligonucleotide sequence, SEQ ID NO: 11, can have two different or non-identical structural compositions.

On page 16 of the amended specification, the structural composition of SEQ ID NO: 12 is indicated to be TTTCTAGATCCAAAGTAA, whereas the structure of SEQ ID NO: 12 on page 6 of the substitute raw sequence listing filed 06/16/04 is recited as: 'tttctagatc caaagtaac agggtatcg'. It is unclear how the same oligonucleotide sequence, SEQ ID NO: 12, can have two different or non-identical structural compositions.

The structure of SEQ ID NO: 11 and SEQ ID NO: 12 provided in the specification and raw sequence listing do not match. Correction/clarification is requested.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

**Applicants' Amendment**

2) Acknowledgment is made of Applicants' amendment filed 06/16/04 in response to the *Ex parte Quayle* Action mailed 04/13/04 which has been entered. Applicants have filed an amended specification and a substitute raw sequence listing, which fix the formal matters identified in paragraph 1 of the *Ex parte Quayle* Action mailed 04/13/04.

**Status of Claim(s)**

3) Claim 11 is pending and is under examination.

Serial Number: 09/612,925  
Art Unit: 1645

### Remarks

- 4) Claim 11 is allowable.
- 5) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The RightFax number for submission of amendments or other papers is (703) 872-9306.
- 6) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAG or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.Mov>. Should you have questions on access to the Private PAA system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
- 7) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (571) 272-0864.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

September, 2004

  
S. DEVI, PH.D.  
PRIMARY EXAMINER